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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,924	11/10/1999	TAKASHI HIROSE	P/2371-27	8642

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EXAMINER

WU, ALLEN S

ART UNIT	PAPER NUMBER
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2131

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DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PR4

Office Action Summary	Application No.	Applicant(s)	
	09/437,924	HIROSE, TAKASHI	
	Examiner	Art Unit	
	Allen S. Wu	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 336474/1998, filed on 12/11/1998.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 741 and 742 referred to on page 9 line 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: S6 shown in figure 3. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanjo Patent Number JP406119363A.

In regards to claim 4, Nanjo discloses an electronic document management system comprising: a document storage unit for storing electronic documents, a signature image storage unit for storing and supplying the attest information upon request (admission of prior art pages 1 and 2). Although Nanjo teaches attest data synthesized with the data on the document, he does not teach the signature image being used as approval of the electronic document by a signer. However, this feature is to be inherent to the Nanjo system as the purpose of using authorization data as a method of approval of an electronic document. Furthermore, Nanjo teaches synthesizing authorization data with the electronic document before outputting to an output device (admission of prior part page 2). Nanjo does not teach storing the electronic document in association with one attest data in the document storage system. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to substitute the output device with a document storage system because it will allow for convenient retrieval of a document that has been attached with registered signature image data. Storing the document, instead of outputting, requires a rerouting of the document from the output device to a storage device.

In regards to claim 5, Nanjo discloses retrieving document and attest data based on the signer ID. It is to be inherent that the document and attest information will have to be stored in respect to

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the signer ID in order for retrieval based on the signer ID. However, Nanjo does not teach storage of ID numbers of attest data storage system in the document data storage system and ID numbers of document data storage system in attest data storage system. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add the ID numbers as extra document data and attest data because storing system ID numbers in the respective storage system is added information to aid the identification and authentication of the document.

In regards to claim 6 and 7, Nanjo discloses signal processor for reading the electronic document from the document storage system and attest information from the attest storage system based on the signer ID (Abstract). Nanjo does not teach the data storage system receiving signature images from the attest data storage system upon approval by the signer. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a computer network in place of a signal processor because the network will provide a better means of communication between the two storage systems and allow the systems to perform send/receive tasks with each other. With an established communication between the two systems, it is inherent to send and receive pertinent information, like the signature image, to and from one system to synthesize attest data to the electronic document.

In regards to claim 8, Nanjo discloses storage of authorization information including locations/sizes, etc (Abstract). Nanjo does not teach the storage of signature image in association with both the ID number of the document data storage the ID number of the signer. The addition

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of the ID number of the document data storage is further information for the convenience of identifying where the electronic document is stored. Furthermore, Nanjo does not teach storing of the electronic document in association with the signer ID and the ID number of the attest data storage system. This is extra information that can be stored with the document for identification of who created the document and where the attest information for the signer is located. It would have been obvious to one of ordinary skill in the art to add ID number information to the storage of both the electronic document and attest information as more information of the identification information and authorization information because it will improve the efficiency of identification and verification methods.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanjo, Patent Number JP406119363A, in view of Tabata et al.

In regards to claim 1, Nanjo discloses an electronic document management system comprising: a document storage unit for storing electronic documents, a signature image storage unit for storing and supplying the attest information upon request (admission of prior art pages 1 and 2). Nanjo does not teach the use of a computer network with a plurality of computer systems for supplying the electronic documents. It is to be inherent to the invention of Nanjo to use computer systems in a network to supply the electronic document with a signature image. An electronic document needs to be generated by some means and sent to the document storage unit by another means, such as a computer system coupled to a network. Furthermore, Nanjo does not teach the storing of bar codes for ID numbers of attest data storage system, document data

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storage system, and document number of the electronic document. Tabata et al. discloses a document storage medium for storing electronic documents with a three-dimensional bar code for document management information (Abstract). It would be obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Tabata et al. within the system of Nanjo because it would allow the use of barcodes as a means to record document management information and attest management information to an electronic document management system.

In regards to claim 2, Nanjo discloses the storage of authorization information. However, Nanjo does not teach the storage of storage of the serial usage number by the signer. The use of the serial usage number is another means for attesting by the signer, which is added authorization information not taught by Nanjo. It would have be obvious to one of ordinary skill in the art at the time of the applicant's invention to include the serial usage number as extra attest data because it would add extra authentication information to the attest data to be stored. It is also noted that storing the number as a bar codes would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for reasons mentioned above.

In regards to claim 3, the combination of Nanjo and Tabata et al. does not teach the attachment of a plurality of signature images to an electronic document. Attaching a plurality of signature images to a document is a similar method of synthesizing one image to an electronic document, which is disclosed by Nanjo. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to synthesize more than one signature image from different

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attest data storage systems to an electronic document because of the need to have more than one signer on a document.

6. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanjo, Patent Number JP406119363A, in view of Khan et al., US Patent 6,401,206.

As per claim 9, Nanjo discloses an electronic management system comprising: a document storage unit for storing electronic documents, a signature image storage unit for storing and supplying the attest information upon request (admission of prior art pages 1 and 2). Nanjo does not teach the method of registering the signature image with a signer ID and the steps of obtaining approval of a signature signing the signature image before registering the signature image data. Khan discloses a method of obtaining information for a digital identity (Fig. 4, col 6 lines 23-47), registering the identity with a signature image (col 6 lines 69-67), storing the created digital identity (col 10, lines 30-34) and attaching the digital identity in the form of a signature impression on the document (col 8, lines 48-56). It is noted that a signature impression is similar to a signature image referenced to in the specifications. It is further noted that the request for a user name and password is used as a means for signer identification. Therefore, it is to be inherent to use an ID number in place of a user name and password for identification means. Furthermore, the combination of Nanjo and Khan et al. does not teach the temporary storage of a primary document with a signature image. The document storage system can store an electronic document for an indefinite amount of time, depending on the system. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to

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temporarily store the document with a signature image in the document storage system, disclosed by Nanjo, before obtaining and attaching the registered image data from the attest data storage system because of the need to save the electronic document while authorization information is being generated. Furthermore, the combination of Nanjo and Khan et al does not teach storing of a secondary document data with the registered signature image data. It would have been obvious to one of ordinary skill in the art to use the teachings of Nanjo to attach registered signature image data to a document and save the document instead of outputting it to an output device because of the convenience of future retrieval of the electronic document with the registered image data.

In regards to claims 10 and 11, Nanjo discloses the storage of document management data and storage of authorization information, such as authorization location and number. The combination of Nanjo and Khan et al. does not teach the storing of a system ID number of system registering image data with the secondary document data and system ID number of system storing secondary document data with the signature image data. This is added information that can be added to the document management data and authorization information respectively. It would have been obvious to one of ordinary skill in the art to include the system ID number with the document management data and attest information data respectively because of the added efficiency of system identification means.

In regards to claim 12, Nanjo discloses transferring of registered signature image data for attachment to an electronic document. Khan discloses a method for authenticating the user of the

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digital identity before attaching the signature impression to an electronic document. It is to be inherent that authenticating the user of the digital identity serves the same purpose of approval by a signature signing the signature image in the electronic document. It is also noted that the approval of the signature signing the signature image must be done before attaching the registered signature image to the document because of the purpose of verification of the signer.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,557,102 to Wong et al. discloses an image management system

US Patent 5,818,955 to Smithes et al. discloses a method and system of electronic document verification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen S. Wu whose telephone number is 703-305-0708. The examiner can normally be reached on Monday - Friday 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are N/A for regular communications and N/A for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


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Allen S. Wu
Examiner
Art Unit 2131

ASW
August 7, 2003


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